

REMARKS

With entry of this amendment, claims 1-57 are pending in the application. By this amendment, claims .1-27, 33-36, 45-50, 52, and 55-57 have been amended in accordance with the Examiner's suggestions, for clarity and without intent nor effect to limit the claims. All the amendments presented herein are fully supported by the disclosure, and no new matter has been added to the application. Entry of these amendments and reconsideration of the application in view of the accompanying remarks is earnestly solicited.

Species Election Requirement

The Office asserts that the application claims patentably distinct species corresponding to each of the Figures 1-7. Applicant hereby elects species I, Figure 1 for initial examination. This election is made with traverse, and no representations are made by this election concerning the merits of the species election requirement with respect to the possible existence of multiple distinct species of the invention among the originally presented claims. Applicants respectfully request that examination of related and/or common features among the indicated species, and further solicit the Office to reconsider the species election requirement in the interests of compact prosecution and/or rejoin non-elected species presently or upon allowance of a generic claim.

Patentability Under 35 USC § 112

Claims 1-27, 45-47, 49-50, 52, and 55-57 are rejected under 35 USC § 112 as allegedly indefinite in the recitation of "said fluid"—which the Office contends is grammatically inconsistent with recitation of "fluid product". While Applicant believes the intended meaning of the term fluid as a noun, versus as an adjective, would have been readily understood and therefore the original claims were consistent with the cited statutory requirements for definiteness, the claims have been amended herein for clarity, without prejudice nor intent nor effect to limit the scope of the claims, in accordance with the Examiner's suggestions, thereby obviating the asserted grounds for rejection.

The Examiner kindly notes that claims 2-6, 9-19, 21-22, and 25-27 fail to precisely accord the preamble term "packet" with the respective base claim term

“product”. Appropriate correction of this minor drafting error is presented in the claims herein for clarity, without prejudice, nor intent nor effect to limit the scope of the claims, in accordance with the Examiner’s suggestions, thereby obviating the asserted objection.

Also kindly noted by the Examiner are formal objections pertaining to the preamble language “The sidewall areas” in claims 7-8, and 34-35; “The laser and toner means” of claims 20 and 46; and “The insert” of claims 23-24. Appropriate corrections of these minor drafting errors are presented in the claims herein for clarity, without prejudice nor intent nor effect to limit the scope of the claims, in accordance with the Examiner’s suggestions, thereby obviating the asserted objections.

Additional formal objections are presented at pp. 2-3 of the Office Action relating to clarity, antecedent basis and other formalities pertaining to the claims originally presented in the application. Each of these formal objections has been considered and where appropriate corrections have been presented in the claims herein for clarity, without prejudice nor intent nor effect to limit the scope of the claims, in accordance with the Examiner’s suggestions, thereby obviating the asserted objections.

Patentability Under 35 USC § 102

Applicant notes for the record that the Office has considered the application and pending claims and has not levied a rejection of any claim under 35 USC § 102, on which basis Applicant believes that the Office considers the pending claims free of the art with respect to this section of the Patent Act (i.e., novelty/anticipation).

Patentability Under 35 USC § 103

Claims 1, 4-6, 10, 13, 15, 17-28, 31-33, 36, 39, 41, and 43-57 are rejected as under 35 USC § 103 as allegedly unpatentable over Cole (713,606) in view of one of Salfisberg (2,298,421) and Paley (5,814,959) (sic; 5,814,159). Cole is cited for allegedly disclosing a container (2) with a transparent sidewall, a quantity of useful liquid product sealed in the container and an insert (1) bearing a meaningful communication enclosed within the container, the insert in contact with the liquid product and viewable through the transparent sidewall. Salfisberg and Paley et al. are relied upon as secondary references allegedly each disclosing “locating a useful flowing product . . . in a polymeric

packet". Based on these combined teachings, the Office contends that it would have been obvious "[t]o modify the basic product or packet teaching of Cole employing an alternative container such as a transparent packet as disclosed by one of Salfisberg and Paley et al. . . . as a substitution of analogous container means."

Applicant respectfully traverses the foregoing grounds for rejection and submits that the invention set forth in the instant claims, while apparently recognized by the Office as novel over the art of record, is neither disclosed nor practically suggested by the cited references viewed in combination as advocated by the Office.

Applicant notes that the disclosure by Cole is limited to a cylindrical glass bottle containing a liquid (oil) in which a label (paper) enclosed within the container floats. Salfisberg discloses an unrelated display package containing a flowing powder with one sidewall of the package transparent to display the powder. Paley et al. teaches an unrelated cleaning device with a plastic bag containing cleaning liquid.

In characterizing the primary and secondary references cited above, the Office focuses on the glass bottle container of Cole and asserts that the secondary references would practically motivate a skilled artisan to replace the glass bottle with a container having polymeric sidewalls as allegedly disclosed by Salfisberg and Paley et al.

Applicant respectfully submits that there is no evidence of record pointing to a "practical" motivation that would have led an artisan of ordinary skill to modify the primary reference by Cole in the manner advocated by the Office, i.e., to substitute the cylindrical glass bottle of Cole containing a label in contact with a fluid product enclosed within the cylindrical glass bottle, with a display package as taught by Salfisberg for displaying powdered products, or with a plastic bag component of the cleaning device disclosed by Paley et al. On the contrary, the primary reference by Cole, which is the only reference that speaks to containers incorporating interior labels in contact with a fluid product, teaches directly away from the proposed modification.

In particular, Cole employs a cylindrical glass bottle for a definite purpose and function that is distinct from the purpose and function of the instantly-claimed package, particularly as these containers function in conjunction with an internal label suspended in a fluid product. As described, for example, at column 1, lines 42-45, Cole states:

In order to obtain a high degree of refraction and thereby cause the label to be considerably magnified, I prefer to employ a bottle of cylindrical form.

Thus, Cole expressly teaches the artisan to employ a glass material shaped into a cylindrical form to provide refraction and function by virtue of its cylindrical shape to magnify the label suspended in the fluid product.

The Federal Circuit has held as a “useful general rule” that “a reference that ‘teaches away’ can not serve to create a *prima facie* case of obviousness.” In re Gurley, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a path divergent from that taken by the applicant. Id., 31 USPQ2d 1130, 1131.

Here, the express teaching by Cole that the disclosed container with a suspended label in a fluid product should be constructed of glass, and provided in a cylindrical form, to enhance refraction and magnification and thereby facilitate viewing of the label, must be construed as teaching directly away from Applicant’s claimed invention. Any suggestion to manufacture the product of Cole from a flexible polymer, to achieve a packet containing a label in contact (anchored or suspended) with a fluid product, would be directly contrary to the teachings of Cole, and in fact would be inoperable for the purpose and result disclosed by Cole (of optimizing refraction and magnification to enhance viewing of the label).

As stated by the Federal Circuit in In re Gordon (221, USPQ 1125, 1127, 1984):

[T]he proposed modifications would render the respective prior art devices inoperable for their intended functions, as discussed above, which is also a strong indicator that the invention is non obvious.

Applying this authority to the present facts, there is no evidence to support a suggestion among the cited references, nor elsewhere in the record, to substitute the cylindrical glass bottle construction of Cole container with a flexible polymer packet design. In fact, to make the modification of Cole advocated by the Office would contravene the principal object of the Cole’s container/label design--because a flexible

polymer packet as presently claimed would not provide the refractive properties and label magnification described for Cole's cylindrical glass container.

With respect to the secondary references, there is clearly no teaching in either of the Salfisberg reference teaching a polymer container for powdered products, nor the Paley et al. cleaning device plastic bag component, that amounts to an express or inherent, practical suggestion to modify the Cole container as advocated by the Office. Neither of these references speaks in any manner of the instantly claimed element comprising a label in contact with (anchored or suspended in) a liquid medium, within any form of container. On the contrary, these secondary references similarly teach away from this subject matter—Salfisberg teaching a container for powdered products; Paley et al. teaching a cleaning device that includes a structurally and functionally distinct plastic bag component. Thus, only Cole provides evidence of record with respect to desired or suggested features for a container enclosing a label suspended in a liquid product, and this reference expressly teaches away from the proposed modification advocated by the Office to substitute a polymeric packet for the glass bottle design of Cole.

In view of the foregoing, Applicant respectfully submits that the Office has not established *prima facie* evidence to support the rejection of claims 1, 4-6, 10, 13, 15, 17-28, 31-33, 36, 39, 41, and 43-57 under 35 USC § 103 as allegedly unpatentable over Cole (713,606) in view of one of Salfisberg (2,298,421) and Paley (5,814,159).

Dependent claims 22-24 and 48-50 are rejected on the same grounds asserted above for the respective base claims, and on the further basis that these claims allegedly fail to provide any new or unexpected results (multiple piece communications, e.g., puzzles). As the facts and authority presented above evince patentability of the subject base claims to claims 22-24 and 48-50, these dependent claims are likewise respectively submitted to be patentable over the art of record. In addition, the Office's blanket assertion that multiple piece communications are not "new and unexpected" fails to satisfy the burden imposed on the Office to show that each and every element and limitation of the rejected claims is disclosed or suggested among the cited references. Absolutely no teaching or combination of teachings is proffered by the Office to support this rejection, whereby Applicant rightfully declines further comment on the issue of patentability of these claims.

Dependent claims 25-26 and 51-52 are also rejected on the same grounds asserted above for the respective base claims, and on the further basis that it would allegedly be obvious “to render the communication unobtainable until removal from the packet.” As the facts and authority presented above evince patentability of the subject base claims to claims 25-26 and 51-52, these dependent claims are likewise respectively submitted to be patentable over the art of record. In addition, the Office’s blanket assertion that a communication unobtainable without removal from the packet is obvious fails to satisfy the burden imposed on the Office to show that each and every element and limitation of the rejected claims is disclosed or suggested among the cited references. Absolutely no teaching or combination of teachings is proffered by the Office to support this rejection, whereby Applicant rightfully declines further comment on the issue of patentability of these claims. Notably, however, the sole reference of record that provides any teachings with regard to container-enclosed labels, Cole, expressly emphasizes that the label should be viewable at all times, and in fact that viewing should be enhanced by employment of a cylindrical glass container design. (See, e.g., column 1, line 46 to column 2, line 50; “the label being discernable by virtue of the transparency of the bottle and fluid and the same being magnified . . .”). Cole also expressly teaches that the label itself should be specifically constructed to prevent obscuring of any part of the label message, which expressly teaches away from the subject matter of Applicant’s invention. For example, column 1, lines 24-30 of Cole teach that:

The label shown is longer than the diameter of the bottle and is of a width slightly less than the diameter. This is necessary *in order that the label may not turn around on the bottle or get down flat on the bottom or in any other position so that it cannot be read.* (emphasis supplied).

With regard to claims 55-57, Applicant’s methods, which the Office asserts would “flow naturally from the intended use disclosed”, on the Office’s own reasoning are distinguished from the art of record in view of the foregoing facts and authority as applied to the corresponding product/packet claims.

Claims 1, 4-6, 10, 13, 15, 17-28, 31-33, 36, 39, 41, and 43-57 are rejected under 35 USC § 103 as allegedly unpatentable over Cadwell (956,937) in view of one of Salfisberg (2,298,421) and Paley et al.

In support of this rejection, the Office relies on Cadwell for essentially the same teachings attributed to Cole above. Among the cited teachings of Cadwell, the Office contends that this reference teaches “a quantity of useful liquid product sealed in the container and an insert (D) bearing meaningful communication enclosed within the container, *the insert in contact with the liquid product*, the insert being viewable through the transparent sidewall.” (emphasis supplied). Salfisberg and Paley et al. are relied on as above for allegedly disclosing flowing products contained in polymeric packets.

Applicant respectfully traverses the foregoing grounds for rejection and submits that the invention set forth in the instant claims, while recognized by the Office as novel over the art of record, is neither disclosed nor practically suggested by the cited references viewed in combination as advocated by the Office.

Applicant believes that the instant rejection is defective based on a simple misconstruction of the Cadwell reference. Contrary to the Office’s interpretation that this reference teaches “*the insert in contact with the liquid product*”, as noted above, Cadwell expressly discloses that the insert (card or label) is protected from contacting the liquid product by placing the card or label in a separate capsule. For example, at column 2, lines 65-68, Cadwell teaches that:

The placing of the advertisement when in card or label form within the hermetically sealed capsule or tube prevents the dame from being injured.

Accordingly, the proposed combination of Cadwell with Salfisberg or Paley is facially deficient as a basis for rejecting the subject claims, which each recite an insert that is “in contact with said fluid product”. Because the cited references, even if combined as advocated by the Office, fail to teach or practically suggest all of the elements and limitations of Applicant’s invention, the instant rejection is respectfully submitted to be overcome.

Dependent claims 22-24 and 48-50 are rejected on the same grounds asserted above for the respective base claims, and on the further basis that these claims allegedly fail to provide any new or unexpected results (multiple piece communications, e.g., puzzles). As the facts and authority presented above evince patentability of the subject base claims to claims 22-24 and 48-50, these dependent claims are likewise respectively

submitted to be patentable over the art of record. In addition, the Office's blanket assertion that multiple piece communications are not "new and unexpected" fails to satisfy the burden imposed on the Office to show that each and every element and limitation of the rejected claims is disclosed or suggested among the cited references. Absolutely no teaching or combination of teachings is proffered by the Office to support this rejection, whereby Applicant rightfully declines further comment on the issue of patentability of these claims.

Dependent claims 25-26 and 51-52 are also rejected on the same grounds asserted above for the respective base claims, and on the further basis that it would allegedly be obvious "to render the communication unobtainable until removal from the packet." As the facts and authority presented above evince patentability of the subject base claims to claims 25-26 and 51-52, these dependent claims are likewise respectively submitted to be patentable over the art of record. In addition, the Office's blanket assertion that a communication unobtainable without removal from the packet is obvious fails to satisfy the burden imposed on the Office to show that each and every element and limitation of the rejected claims is disclosed or suggested among the cited references. Absolutely no teaching or combination of teachings is proffered by the Office to support this rejection, whereby Applicant rightfully declines further comment on the issue of patentability of these claims. Notably, however, Cole teaches away from this aspect of the invention, as noted in more detail above, by expressly emphasizing that the label should be viewable at all times—an asserted critical function enhanced by employment of a cylindrical glass container design, and by special design of the label "*in order that the label may not turn around on the bottle or get down flat on the bottom or in any other position so that it cannot be read.*" (column 1, lines 24-30, emphasis added).

Claims 1, 4-6, 9-10, 14-16, 19-21, 25-28, 31-33, 35-36, 40-47, and 51-57 are rejected under 35 USC § 103 as allegedly unpatentable over Salfisberg (2,572,056) in view of one of Salfisberg (2,298,421) and Paley et al. ('159).

The Office relies upon Salfisberg '056 for essentially the same teachings as are attributed by the Office to Cole, above. Salfisberg '421 and Paley et al. are likewise cited as above, for allegedly disclosing flowing products contained in polymeric packets.

Applicant respectfully traverses the foregoing grounds for rejection and submits that the invention set forth in the instant claims, while recognized by the Office as novel over the art of record, is neither disclosed nor practically suggested by the cited references viewed in combination as advocated by the Office.

Applicant believes that the instant rejection is defective based on a simple misconstruction of the Salfisberg '056 reference. Contrary to the Office's interpretation, Salfisberg '056 does not describe, in any form, an "insert in contact with the liquid product . . . viewable through the transparent sidewall". The specification and drawings of Salfisberg '056 merely describe labels (6) attached or fixed to an exterior surface of the container by various means. No inserts are disclosed nor fairly suggested by this reference, much less an insert in contact with a liquid product and "viewable through the transparent sidewall". All labeling described in Salfisberg '056 is evidently provided on an exterior surface. In particular, Figures 5, 6, 7, and 8 all clearly show the label (#6) as an exterior layer above the sheets (#1 and #2) that form the commodity compartment.

In view of the foregoing, the proposed combination of Salfisberg '056 with Salfisberg '421 or Paley is facially deficient as a basis for rejecting the subject claims, which each recite an insert that is "in contact with said fluid product", "enclosed within said packet" and "wholly or partially viewable through said transparent sidewall." Because the cited references, even if combined as advocated by the Office, fail to teach or practically suggest all of the elements and limitations of Applicant's invention, the instant rejection is respectfully submitted to be overcome.

Claims 2-3, 11-12, 29-30, and 37-38 are rejected under 35 USC § 103 as allegedly unpatentable over the art as applied to claims 1 and 28 above, and further in view of Hoynack (3,598,609). Hoynack is cited secondarily to the above-discussed primary and secondary reference combinations, for allegedly disclosing "a transparent food packet constructed of food grade polymer film (polyethylene)." On this basis the Office proposes further modification of the asserted art applied to claims 1 and 28 involving substitution of polyethylene as a transparent package material.

Applicant respectfully submits that independent claims 1 and 28 are patentable over the art of record as cited above, whereby the primary basis for the instant rejection of dependent claims 2-3, 11-12, 29-30, and 37-38 is similarly believed to be overcome.

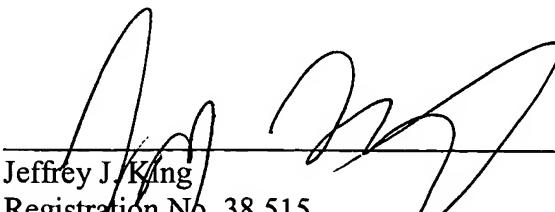
Hoynack clearly fails to cure the deficiencies of the primary and secondary art combinations addressed above, and no corollary teachings are even attributed by the Office to Hoynack apart from the subject of polyethylene film--on which basis the instant rejection should also be withdrawn.

Claims 7-8, and 34-35 are rejected under 35 USC § 103 as allegedly unpatentable over the art as applied to claims 6 and 33 above, and further in view of Farmer (2,093,976). Farmer is cited secondarily to the above-discussed, primary and secondary reference combinations, for allegedly disclosing "a surface treated to be opaque." On this basis the Office proposes further modification of the asserted art applied to claims 6 and 33 involving substitution of "opaqueness to the packet of the combinations above."

Applicant respectfully submits that base claims 6 and 33 (which depend in turn from independent claims 1 and 28), respectively, are patentable over the art of record as cited above, whereby the primary basis for the instant rejection of dependent claims 7-8, and 34-35 is similarly believed to be overcome. Farmer clearly fails to cure the deficiencies of the primary and secondary art combinations addressed above, and no corollary teachings are even attributed by the Office to Farmer apart from the vague concept of "opaqueness" --on which basis the instant rejection should also be withdrawn.

In view of the foregoing, Applicant believes that all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at (425) 455-5575.

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